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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/768,023

02/02/2004

Nozomi Sawada

246853US-2 DIV

7240

22850

7590

09/08/2008

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER

KAU, STEVEN Y

ART UNIT

PAPER NUMBER

2625

NOTIFICATION DATE

DELIVERY MODE

09/08/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/768,023	SAWADA, NOZOMI	
	<b>Examiner</b>	<b>Art Unit</b>	
	STEVEN KAU	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 29 May 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-6,9-15 and 18-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6,9-15 and 18-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                          | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's amendment was received on 5/29/2008, and has been entered and made of record. Currently, claims 1-6, 9-15 & 18-23 are pending and claims 7-8 & 16-17 has been cancelled.

Applicant has filed a terminal disclaimer on 5/29/2008, thus rejection based on nonstatutory double patenting is overcome.

### ***Response to Remark/Arguments***

2. Applicant's arguments with respect to claims 1-6, 9-15 & 18-23 have been fully considered and persuasive. However, Kuwamoto et al' 518 reference together with Kakutani' 794 reference teach claims 1-6, 9-15 & 18-23. Detail of rejection is discussed in the following section.

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The examiner also references the applicant to the claims rejection section below for the explanation on how the prior art references read on the amended claims.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3-6, 9, 10, 12-15, and 18-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuwamoto et al (Kuwamoto) (US 5,617,518) in view of Kakutani (US 6,817,794).

Regarding claim 1.

Kuwamoto discloses an image forming apparatus (**Print Server 202 of Figs. 1 & 2, col 8, lines 5-12**) comprising: a memory (**Hard Disc 26 and Main Memory 21 of Fig. 2**) configured to store setting information (**Print Programs 720, Print Program Files 700 of Fig. 6 and Print Program Management table 500 of Fig. 4, col 9, lines 17-44**) including at least a size of a substitute recording medium (**different paper size, col 20, lines 35-41**) for each user (**individual user registers print program, col 15, lines 17-20; thus, print command file 7000 of Fig. 24 designating user's ID for print job, col 17, lines 35-41**); and a processor (**CPU 10 and CPU 20 of Fig. 2**) configured to execute a print instruction (**print program**) by automatically changing (**switching by the page printing setting print command 7300**) a size of a recording medium to be used to the size of the substitute recording medium (**different paper size**) based on the setting information stored in said memory (**print command 7300 is**

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**contained in print command file 7000 of Fig. 24, which stored in hard disc, col 16, lines 46-60).**

Kuwamoto does not explicitly disclose automatically changing a size of a recording medium to be used to the size of the substitute recording medium when the size of the recording medium specified by the print instruction is not available.

Kakutani teaches a processor configured to execute a print instruction by automatically changing a size of a recording medium to be used to **(e.g. specified by a print job)** the size of the substitute recording medium based on the setting information stored in said storage means memory **(e.g. setting information registered in alternative table which is stored in the memory of Figure 19)**, when the size of the recording medium specified by the print instruction is not available **(col 11, line 34 to col 12, line 27 & Fig. 20).**

Having an image forming apparatus of Kuwamoto' 518 reference and then given the well-established teaching of Kakutani' 794 reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the image forming apparatus of Kuwamoto' 518 reference to include automatically changing a size of a recording medium to be used to the size of the substitute recording medium when the size of the recording medium specified by the print instruction is not available as taught by Kakutani' 794 reference since doing so would improve user's productivity and operability without interruption in printing out a job, and further the services provided could easily be established for one another with predictable results.

Regarding claim 3.

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Kuwamoto discloses wherein the memory is configured to store the setting information in response to an external setting instruction from outside (e.g. in response to word processor of 201a-c of Fig.1 1, col 8, lines 5-67).

Regarding claim 4.

Kuwamoto discloses that a notifying device (CPU 20 of Fig. 2) configured to notify to the outside (201a-c of Fig 1) when the size of the recording medium specified by the print instruction is not available (e.g. paper finished, col 20, lines 35-41) or when corresponding setting information is not stored in the memory, together with information indicating an available size (different paper size) of the recording medium, so as to request the setting instruction (switching setting print command 7300) (Fig. 12, col 11, lines 56 through col 12, line 12 & col 20, lines 35-41).

Regarding claim 5.

Kuwamoto discloses a setting device configured (CPU 10 and 20 of Fig. 2) to set and store the setting information in the memory (col 8, lines 16-67).

Regarding claim 6.

Kuwamoto discloses wherein said setting information is stored in said memory storage means in the form of a table (Fig. 4, col 9, lines 17-25).

Regarding claim 9.

Kuwamoto discloses wherein said setting information is stored in said memory with respect to each user (e.g. print command file of Fig 24 designating user's ID for print job, col 17, lines 35-41).

Regarding claim 10.

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Claim 10 recites identical features as claim 1, except claim 10 is an image forming method claim. Thus, arguments similar to that presented above for claim 1 are also equally applicable to claim 10.

Regarding claim 12.

Claim 12 recites identical features as claim 3, except claim 12 is an image forming method claim. Thus, arguments similar to that presented above for claim 3 are also equally applicable to claim 12.

Regarding claim 13.

Claim 13 recites identical features as claim 4, except claim 13 is an image forming method claim. Thus, arguments similar to that presented above for claim 4 are also equally applicable to claim 13.

Regarding claim 14.

Claim 14 recites identical features as claim 5, except claim 14 is an image forming method claim. Thus, arguments similar to that presented above for claim 5 are also equally applicable to claim 14.

Regarding claim 15.

Claim 15 recites identical features as claim 6, except claim 15 is an image forming method claim. Thus, arguments similar to that presented above for claim 6 are also equally applicable to claim 15.

Regarding claim 18.

Claim 18 recites identical features as claim 9, except claim 18 is an image forming method claim. Thus, arguments similar to that presented above for claim 9 are also equally applicable to claim 18.

Regarding claim 19.

Claim 19 recites identical features as claim 1, except claim 19 is a computer-readable storage medium claim. Thus, arguments similar to that presented above for claim 1 are also equally applicable to claim 19.

Regarding claim 20.

Claim 20 recites identical features as claim 1, except claim 20 is a computer-readable storage medium claim. Thus, arguments similar to that presented above for claim 1 are also equally applicable to claim 20.

Regarding claim 21.

Kuwamoto discloses wherein the computer program (e.g. print program 720 and print program file of Fig 6) is with respect to one of a computer within a host unit (e.g., print server 202 of Fig. 1 and Fig. 2) which outputs the print instruction with respect to an image forming apparatus (col 15, lines 61 through col 16, line 9 for one embodiment) and a computer within the image forming apparatus which prints the information on the recording medium (col 18, line 59 through col 19, line 58).

Regarding claim 22.

Claim 22 recites identical features as claim 1. Thus, arguments similar to that presented above for claim 1 are also equally applicable to claim 22.

Regarding claim 23.



Claim 23 recites identical features as claim 1, except claim 23 is an image forming method claim. Thus, arguments similar to that presented above for claim 1 are also equally applicable to claim 23.

5. Claims 2 & 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuwamoto et al (Kuwamoto) (US 5,617,518) in view of Kakutani (US 6,817,794) as applied to claims 1 and 10 above, and in view of Cloutier et al (Cloutier) (US 6,018,397).

Regarding claim 2.

Kuwamoto differs from claim 2, in that he does not expressly disclose wherein said setting information includes whether or not a zoom is required when printing information, and/or a printing position on the recording medium.

Cloutier teaches wherein said setting information includes whether or not a zoom is required when printing information, and/or a printing position on the recording medium (print aspect ratio, size and zoom, col 3, lines 2-12).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kuwamoto' 518 combined with Kakutani' 794 to include setting information includes whether or not a zoom is required when printing information, and/or a printing position on the recording medium taught by Cloutier to allow user to select desired image parameter settings to produce hardcopies with satisfactory image quality (col 1, lines 60-64).

Regarding claim 11.

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Claim 11 recites identical features as claim 2, except claim 11 is an image forming method claim. Thus, arguments similar to that presented above for claim 2 are also equally applicable to claim 11.

***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Kau whose telephone number is 571-270-1120 and fax number is 571-270-2120. The examiner can normally be reached on M-F, 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, King Poon can be reached on 571-272-7440. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Steven Kau/  
Examiner, Art Unit 2625  
8/29/2008

/King Y. Poon/  
Supervisory Patent Examiner, Art  
Unit 2625